

### **REMARKS**

The present application has pending claims 1-6. No amendments were made to the claims.

In paragraphs 1.1 and 1.2 of the Office Action the Examiner acknowledged receipt of the certified copy of the priority document Japanese Patent Application 2001-205542. However, the Examiner appears to allege that the claim for priority under 35 USC §119 should be made in the specification under the heading "Cross-Reference to Related Applications". It seems that the Examiner may be confused with a claim for priority under 35 USC §120 and a claim for priority to a foreign filed patent application under 35 USC §119(a). In order for the Examiner to understand the requirements for claiming priority under 35 USC §119(a) the Examiner's attention is directed to MPEP §201.14(d) and 37 CFR §1.78. MPEP §201.14(d) specifically states in the second full paragraph in the left column on page 200-90 thereof that:

"for all applications, the claim to priority need be in no special form.... No special language is required in making the claim for priority and any expression which can be reasonably be interpreted as claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the Oath or Declaration, an application data sheet (37 CFR §1.76) or the application transmittal letter with recitation of the foreign application".

Thus, there is no requirement in the MPEP nor the rules for the claim of priority to be set forth in the specification under a heading "Cross-Reference to Related Application". In the present situation, the claim for priority was set forth in the Declaration/Power of Attorney filed with the application on August 17, 2001. The Examiner's attention is directed to page 2 of the Declaration where it is specifically

stated that Applicants "hereby claim foreign priority under title 35, United States code section 119(a)-(d) of any application... listed below... 2001-205542, Japan, 6/July/2001.

To further perfect the above noted claim for priority, filed on even date herewith is a claim of priority with respect to the above noted foreign priority document. Therefore, Applicants have fully complied with the requirements for claiming priority under 35 USC §119(a) and acknowledgement thereof is respectfully requested.

In paragraphs 2.1 and 2.2 the Examiner alleges that the Information Disclosure Statement filed on August 17, 2001 fails to comply with 37 CFR §1.98(a)(1) and 37 CFR §1.98(a)(3) being that the Examiner alleges that the paper does not include a concise explanation of the relevance of the reference being cited and that the reference being cited is not in the English language.

Contrary to the Examiner's allegations, Applicants have fully complied with the requirements as set forth in 37 CFR §1.98(a)(3)(i) 37 CFR §1.98(a)(3)(i) specifically states that for any information listed in the Information Disclosure Statement that is not in the English language requires a concise explanation of its relevance and such:

"concise explanation may be either separate from  
Applicants specification or incorporated therein"

Thus, as per 37 CFR §1.98(a)(3)(i) a concise explanation of the relevance of the Yamaguchi reference cited in the August 17, 2001 was provided in the specification on page 1, line 8 through page 3, line 3. The Examiner's attention is directed to this passage. Therefore, the August 17, 2001 Information Disclosure

Statement fully complied with the requirements as set forth in 37 CFR §1.98.

Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

The drawings stand objected to due to various informalities noted by the Examiner in paragraphs 3.1 through 3.5 of the Office Action. Filed on even date herewith are Proposed Drawing Corrections to correct the informalities noted by the Examiner. Also, amendments were made to the specification to bring the specification into conformity with the elements as illustrated in the drawings. Therefore, the Examiner's objection to the drawings is overcome and should be withdrawn.

The disclosure stands objected to due to informalities noted by the Examiner in paragraphs 4.1 and 4.2 of the Office Action. Various amendments were made throughout the specification to correct the informalities noted by the Examiner and other minor errors grammatical and editorial in nature discovered upon review. Therefore, this objection is overcome and should be withdrawn.

Claims 1-4 stand rejected under 35 USC §103(a) as being unpatentable over Suzuki (U.S. Patent Application Publication No. 2002/0168033) and claims 5 and 6 stand rejected under 35 USC §103(a) as being unpatentable over Suzuki in view of Dissosway (U.S. Patent No. 4,903,262). Applicants submit that these rejections are rendered moot being that the primary reference Suzuki is only effective as of its actual U.S. filing date, namely October 10, 2001 or its PCT publication date of August 23, 2001, both dates being well after the filing date of August 17, 2001 of the

present application. Therefore, reconsideration and withdrawal of these rejections is respectfully requested.

As the Examiner may be aware 35 USC §102(e) was changed to be retroactively effective to November 29, 2000 so as to set forth the requirements for an international (PCT application) to be effective as prior art relative to U.S. applications. These requirements include (1) that the international application to be used as a prior art reference be filed on or after November 29, 2000, (2) that the international application designate the U.S., and (3) that the international application be published in English. Suzuki, although meeting the first two conditions did not meet the third condition, namely it was not published in English. A copy of the published PCT application which serves as the basis for the filing of the Suzuki U.S. patent application is attached.

Thus, the Suzuki U.S. patent application is only effective as a reference relative to a U.S. patent application as of its actual filing date, namely October 10, 2001 which is well after the filing date of August 17, 2001 of the present application.

Further, the published PCT application of Suzuki is only effective as a reference relative to U.S. patent application as of its publication date, namely August 23, 2001 which again is after the filing date of August 17, 2001 of the present application.

Thus, since Suzuki cannot be used as a reference relative to the claims of the present application the 35 USC §103(a) rejection of claims 1-4 as being unpatentable over Suzuki is rendered moot. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Further, the 35 USC §103(a) rejection of claims 5 and 6 is also rendered moot being that the primary reference Suzuki cannot be used to reject the claims of the present application. Dissosway taken individually does not supply the teachings of Suzuki relative to claims 5 and 6. Dissosway is relied upon by the Examiner in the combination for an alleged teaching of a radio frequency circuit for transmitting and receiving radio frequency signals, a digital signal processor and a receiver as part of the transceiver. There is no allegation that Dissosway can stand alone. Thus, the 35 USC §103(a) rejection of claims 5 and 6 as being unpatentable over Suzuki and Dissosway is also rendered moot. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references utilized in the rejection of claims 1-6.

In view of the foregoing amendments and remarks, Applicants submit that claims 1-6 are in condition for allowance. Accordingly, early allowance of claims 1-6 is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (520.40478X00).

Respectfully submitted,

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